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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/724,814	12/01/2003	Shotaro Takemoto	16224Z	5568

23389 7590 10/06/2006

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EXAMINER

SEVERSON, RYAN J

ART UNIT	PAPER NUMBER
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3731

DATE MAILED: 10/06/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/724,814

Applicant(s)

TAKEMOTO ET AL.

Examiner

Ryan Severson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 September 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 17-24 is/are pending in the application.
- 4a) Of the above claim(s) 18-21 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 17 and 22-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 08 April 2004 is/are: a) ☒ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>12/01/2003</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Applicant's election without traverse of Invention I, an endoscopic treatment device, and Species 21 in the reply filed on September 25, 2006 is acknowledged.
2. Claims 18-20 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on September 25, 2006.
3. Claim 21 is withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on September 25, 2006.

Drawings

4. The drawings are objected to because: Reference numeral 144 on the bottom left of Figure 42 is pointing to tape 143. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary

to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 17 and 24 are rejected under 35 U.S.C. 102(b) as being anticipated by Whitfield et al. (5,470,338). Whitfield et al. reference discloses the invention substantially as claimed, including: a "needle" (12 and 14) with a "thread" (52) fixed thereon; a "recovery member" (see Figure 18) capable of recovering the needle, having an outer periphery portion (the external face of the recovery member) with a "groove" (see Figure 18, the "X" shape in the center of the recovery member) and an "inner hole" (see Figure 18, the holes at the ends of the "X" shape, which provide access to the inner portion of the device and trap the needle); a "guide" formed in an elongated shape (48); an "elongated circular member" (36) capable of being inserted into the guide; and at least one "arm" (57 and 59) provided at a distal end of the elongated circular member. The recovery member is engaged with the elongated circular member in

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Whitfield et al. reference when the elongated member is moved distally, forcing the camming pins (64, 66) distally into contact with the arms (57 and 59), and therefore causing the arms to press against the tip of the needle and the recovery member.

Regarding claim 24, the device has two arms (57 and 59) positioned facing each other (see the exploded configuration in Figure 3).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
 2. Ascertaining the differences between the prior art and the claims at issue.
 3. Resolving the level of ordinary skill in the pertinent art.
 4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
6. Claim 22 is rejected under 35 U.S.C. 103(a) as being unpatentable over Whitfield et al. (5,470,338) as applied to claim 17 above, and further in view of Shimomura et al. (3,839,772). Whitfield et al. reference discloses the invention substantially as claimed, including: a needle, a recovery member with a groove and inner hole, a guide, an elongated circular member, and at least one arm provided at the distal end of the

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circular member. However, Whitfield et al. reference does not disclose that the arms be made of an elastic metal. Attention is drawn to Shimomura et al. reference, which teaches the use of an elastic lever (see column 3, Lines 6-10) to prevent backlash and maintain a strong press against the part being engaged without permanently deforming the lever due to excess stress placed upon it by the pressing means and the part being engaged. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to make the arms of Whitfield et al. reference of an elastic member, as taught by Shimomura et al. reference, to prevent backlash and maintain a strong press against the part being engaged without permanently deforming the lever due to excess stress placed upon it by the pressing means and the part being engaged.

7. Claim 23 is rejected under 35 U.S.C. 103(a) as being unpatentable over Whitfield et al. (5,470,338) in view of Shimomura et al. (3,839,772) as applied to claim 22 above, and further in view of Ouchi (6,013,095). Whitfield et al. reference discloses the invention substantially as claimed, including: a needle, a recovery member with a groove and inner hole, a guide, an elongated circular member, and at least one arm provided at the distal end of the circular member, the arms being made from an elastic member as taught by Shimomura et al. reference. However, neither Whitfield et al. nor Shimomura et al. references disclose that the arms be made of an elastic metal.

Attention is drawn to Ouchi reference, which teaches that an elastic member is metal (see Column 4, Lines 57-59) to provide maximum strength during clamping or pressing while still maintaining the desired elastic characteristics. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to make the

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arms of Whitfield et al. reference as an elastic lever member, as taught by Shimomura et al. reference, with the elastic lever member being metal, as taught by Ouchi reference to provide maximum strength during clamping or pressing while still maintaining the desired elastic characteristics.

Double Patenting

A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

8. Claim 17 is provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claim 17 of copending Application No. 10/958,801. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

Conclusion

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ryan Severson whose telephone number is (571) 272-3142. The examiner can normally be reached on Monday - Friday 8:00 - 5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anhtuan Nguyen can be reached on (571) 272-4963. The fax phone

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number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Ryan Severson
September 27, 2006



ANH TUAN T. NGUYEN
SUPERVISORY PATENT EXAMINER

9/30/06